



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/375,239	08/16/99	MUSSO	E P8910-9024 ^{mk}

IM22/1029
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EXAMINER

SERGEANT, R

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 10/29/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/375,239

Applicant(s)
Musso et al.

Examiner
Rabon Sergeant

Group Art Unit
1711



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-18, 22, and 23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-18, 22, and 23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-18 are rejected under 35 U.S.C. 101 because

the claimed invention is directed to non-statutory subject matter. A "use" is not a statutory class of invention.

3. Claims 1-18, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It applicants intend that the subject matter of claims 1-18 be drawn to a process, then it should be so claimed, and a definitive process step must be claimed.

4. Claims 1-18, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, within claim 1, "low" is a relative term without quantitative meaning.

Secondly, the language, "essentially consisting of" is improper claim terminology. See claims 1, 2 and 4-8.

Thirdly, within species VI, difluoromethoxy has not been spelled correctly.

Fourthly, within claims 4-7, it is improper to state that one specific compound contains another compound.

Fifthly, within claim 11, it is not clear what HFPE1 and HFPE2 represent. Furthermore, the use of "can" renders the claims indefinite, because it is unclear if the language denoted by "can" is a required or optional embodiment. The language, "the ether portion" lacks antecedent basis. Also, the meaning of language pertaining to "hydrofluoropolyethers having

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the same structure" is incomprehensible. One of ordinary skill cannot ascertain what is being claimed by the language.

Sixthly, within claims 12 and 18, the language denoted by "mentioned at" is meaningless.

Seventhly, within claims 13, 15 and 16, the language denoted by "preferably" and "more preferably" renders the claims indefinite, because it cannot be determined if the narrow language is intended to modify the broad language.

Eighthly, it is unclear what it meant by, "including the same foaming agent", in claim 13.

5. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear what claim limitations are set forth by the subject matter of claim 3. It is further unclear what is meant by "is noticed".

6. Claims 8 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Azeotropic compositions are widely held to be unpredictable, in terms of the components and amounts of components that will form an azeotrope. Applicants have not provided adequate enablement for claiming azeotropic compositions derived from all compounds encompassed by the term, "hydrocarbon".

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7. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear what claim limitations are set forth by the subject matter of claim 11.

8. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what limitations are set forth by the subject matter of claims 22 and 23.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 12, 13, 18, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethanes and polyolefins wherein compositions which correspond to applicants' compositions; IV, V, D, and E₃ are disclosed. See abstract. Since azeotropic compositions are disclosed, applicants' percent compositions are considered to be inherently met by the references.

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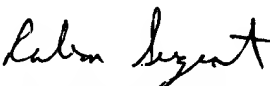
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Any inquiry concerning this communication should be directed to R. Sergent at
telephone number (703) 308-2982.

Sergent/mm

October 25, 1999


**RABON SERGENT
PRIMARY EXAMINER**